



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,768	01/09/2004	Shaohui Shi	GEMS8081.189	1767
27061	7590	01/11/2005	EXAMINER	
ZIOLKOWSKI PATENT SOLUTIONS GROUP, LLC (GEMS) 14135 NORTH CEDARBURG ROAD MEQUON, WI 53097			SHRIVASTAV, BRIJ B	
			ART UNIT	PAPER NUMBER
			2859	

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/707,768

Applicant(s)

SHI ET AL.

Examiner

Brij B Shrivastav

Art Unit

2859

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 1-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-8 is/are rejected.
- 7) ☐ Claim(s) 2 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. Applicant's election with traverse of Group I in the reply filed on November 15, 2004 is acknowledged. The Examiner appreciates applicant pointing out that Group I is the subcombination and Group II is the combination.
2. Regarding the relationship between Group I and Group II, the Examiner disagrees with applicant's arguments that the combination and sub-combination restriction requirements have not been fully satisfied with respect to these two Groups. In this regard, the Examiner notes that the limitation "a non-magnetizable pane operationally connected to **limit separation of one magnet element from another magnetic element**" (**emphasis added**) found in claim 1 (Group I) is not found in claim 9 (Group II). Therefore, under 35 U.S.C. 121, restriction between these two Groups is acceptable, because the combination (Group II) does not include all of the limitations of the subcombination (Group I), as claim 9 and claim 10 respectively include "connection" and "adhesive" in their limitations. But these limitations are neither functionally equivalent nor inherent to the claimed separation limiting Group I. Therefore, under 35 USC 121 restriction between these two Groups is acceptable.
3. Regarding the relationship between Group I and Group III, the Examiner disagrees with applicant's arguments that the combination and sub-combination restriction requirements have not been fully satisfied with respect to these two Groups. In this regard, the Examiner notes that the limitation "a non-magnetizable pane operationally connected to **limit separation of one magnet element from another magnetic element**" (**emphasis added**) found in claim 1 (Group I) is not found in claim

Art Unit: 2859

16 (Group III). Therefore, under 35 U.S.C. 121, restriction between these two Groups is acceptable, because the combination (Group III) does not include all of the limitations of the subcombination (Group I), as claim 9 and claim 10 respectively include "connection" and "adhesive" in their limitations. But these limitations are neither functionally equivalent nor inherent to the claimed separation limiting Group I. Therefore, under 35 USC 121 restriction between these two Groups is acceptable.

4. As regards to the applicant's arguments with respect to Group II and the Group III, the Examiner does not disagree. Therefore, Examiner withdraws that part of the restriction requirement. The Examiner notes that these groups are currently non-elected but this point is not moot, because the applicant inherently reverses the right to prosecute these Groups in further applications.

5. Therefore, claims 1-8 (Group I), which applicant has elected with traverse will be considered for examination on their merit in this Office action. Claims 9-22 stand non-elected. The restriction requirement is still deemed proper and is therefore made FINAL.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 1 and 3-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Kaufman et al (US 5,317,293).

As regards to claim 1, Kaufman et al teach a magnetic field generator assembly, including a plurality of magnetic elements configured to collectively generate a magnetic field sufficient to acquire data for diagnostic purposes (figure 1, 2 and 9). Further, the assembly includes a non-magnetizable pane operationally connected to limit separation of one magnetic element from another magnetic element (figures 5, 6 and 9; column 2, 3, lines 46-68 and 1-54, the cured resin will create a non-magnetizable pane).

As regards to claims 3-8, Kaufman et al further teach a non-magnetizable nylon resin pane with magnetic elements containing some rare earth elements are adhesively attached to it (figures 5-9, column 5-7).

7. Claim 2 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

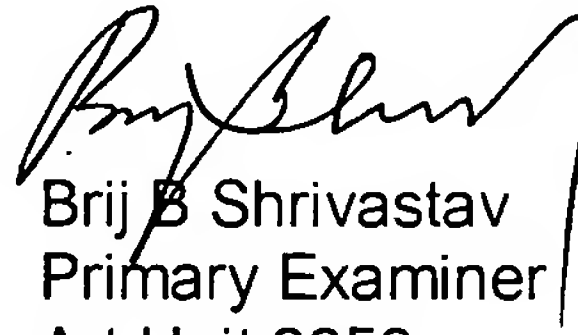
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brij B Shrivastav whose telephone number is 571-272-2250. The examiner can normally be reached on 7 AM to 4 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F. F. Gutierrez can be reached on 571-272-2245. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2859

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

January 5, 2004

  
Brij B Shrivastav  
Primary Examiner  
Art Unit 2859

\*\*\*